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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/656,163

09/08/2003

Byron G. Barefoot

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10/05/2004

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EXAMINER

GONZALEZ, MADELINE

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/656,163             | BAREFOOT, BYRON G.  |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Madeline Gonzalez      | 2859                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-22 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-13 and 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilber (U.S. 3,381,385).

Wilber discloses a tool, as shown in Fig. 3, having:

- a plate 21 having a surface and a plurality of edges;
- at least one fixed measurement structure 23 integrated with an edge of the plurality of edges of the plate 21;
- the at least one fixed measurement structure 23 including: a recessed portion and at least one projection 51-55 extending upward within the recessed portion forming at least one fixed variation measurement structure;
- wherein the at least one fixed variation measurement structure 23 is provided between a sidewall of the projection 51-55 and an opposing sidewall formed from the recessed portion;

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- wherein the at least one fixed variation measurement structure 23 includes a first measurement indicia measuring a distance from an edge of the recessed portion to a farthest edge of the at least one projection 51-55;
- wherein the at least one projection 51-55 is offset from center within the recessed portion;
- wherein the at least one fixed variation measurement structure 23 includes two measurement indicia, a first of the two measurement indicia measuring a distance from a first edge of the recessed portion to a farthest edge from the first edge of the at least one projection 51-55 and a second of the two measurement indicia measuring a distance from a second edge of the recessed portion to a farthest edge from the second edge of the at least one projection 51-55;
- a downslope measuring distance structure; and
- wherein the downslope measuring distance structure includes a measurement indicia from an edge of the recessed portion to a portion on the plate 21;
- wherein the at least one projection 51-55 is positioned at least at one sidewall of the recessed portion;
- wherein the at least one projection 51-55 forming the at least one variation measurement structure is two projections, each positioned at sidewalls of the recessed portion;
- wherein the at least one projection 51-55 forms a stepped portion at the one sidewall;

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- wherein the at least one projection 51-55 provides a narrow recess closer to a bottom portion of the recessed portion with respect to a portion above the at least one projection 51-55 within the recessed portion;
- wherein the at least one projection 51-55 and recessed portion measures maximum and minimum allowable material thickness of a specific thickness of the material;
- wherein the at least one projection 51-55 is at least two projections spaced apart from one another within the recessed portion, wherein one of the two projections is formed at the sidewall of the recessed portion and the at least two projections form two variation measurement structures;
- wherein the recessed portion is a stepped configuration forming at least two stepped portions;
- wherein the recessed portion is a stepped configuration forming a portion lower than remaining portions of the recessed portion;
- wherein the at least one fixed measurement structure 23 measures at least allowable material thickness variation; and
- a method for measuring a maximum and minimum allowable material thickness using the tool having a recessed portion with a stepped configuration, the method comprising the steps of: placing a first portion of the recessed portion over a thickness of the material 11; navigating the first portion over portions of the material; determining whether the first portion slips over the thickness of the material and, if so, then the material thickness is within allowable thickness variation; and

determining whether the material enters a second, narrower portion of the recessed portion and, if not, then the material thickness is within allowable thickness variation.

3. Claims 1, 14, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker (U.S. 4,637,142).

Baker discloses a tool, as shown in Fig. 1, having:

- a plate 3 having a surface and a plurality of edges;
- at least one fixed measurement structure integrated with an edge of the plurality of edges of the plate 3;
- the at least one fixed measurement structure including: a recessed portion and at least one projection 16 extending upward within the recessed portion forming at least one fixed variation measurement structure;
- wherein the at least one projection 16 is four projections, wherein the four projections provide weld bead variation measurements (since the projections 16 are use to indicate measurements from the scale 11) for all wall thicknesses and form at least two variation measurement structures, as shown in Fig. 5;
- wherein: a first projection of the form projections 16 is positioned at a first sidewall of the recessed portion; a second projection of the four projections is positioned at an opposing sidewall of the recessed portion; and a third projection and a fourth projection are spaced apart from one another within the recessed portion and from the first projection and the second projection; and

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- wherein the at least one projection 16 is six projections, wherein the six projections form a stepped configuration at each sidewall of the recess and provide weld bead variation measurements for all wall thicknesses.

*Allowable Subject Matter*

4. Claims 23 and 24 are allowed.

5. Claims 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cummins, Jones, Matson, Lycan et al. ('558), Fujiwara and Barefoot disclose weld gauges. Hirsch, Babcock, Sovereign and Judge disclose gauges having a recessed portion and projections.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243.

The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG



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